

REMARKS/ARGUMENTS

35 USC Section 101

Regarding the 35 USC Section 101 rejections, the claimed invention is directed to statutory subject matter because it produces a useful, concrete and tangible result.

Useful - The claimed invention provides a useful result. The claimed invention presents database search results in response to a user's search terms. It is well-known that search results have specific, substantial and credible utility. Some evidence of this is the multi-billion dollar industry that they are now supporting.

Concrete - The claimed invention provides a concrete result since the results are reproducible. Assuming a given database, search terms and name definitions the results provided by the claimed invention can be deterministically reproduced. Since in most applications these parameters will be changing over time the invention still provides statistically reliable results that are based on the parameters at the time of executing the search.

Tangible - The claimed invention produces a tangible result. Assuming that the underlying database includes "real world" data, the results and benefits provided by the invention will be tangible. Again, it is well-known that database search utilities provide valuable results that have a basis in factual data.

35 USC Section 112

Applicant has addressed the 35 USC Section 112 claim rejections by making suitable amendments.

35 USC Section 102 and 103

Regarding the 35 USC Section 102 and 103 rejections, each of the independent claims 1 and 24-26 includes a limitation that is not disclosed in, nor made obvious in view of, the prior art.

For example, each of claims 1 and 24-26 includes a limitation that a user select first and second terms, and that the second term "is associated with a predetermined list of two or more names". According to the Office Action, these first and second terms are shown in the prior art by Turnbull at Fig. 4 #66 and Fig. 4 #80, respectively. The present claims also recite (i)

identifying documents that “satisfy the first search term,” (ii) “determining a frequency of occurrence of the two or more names in the identified documents” (emphasis added) and (iii) ordering some of the identified documents “according to the determined frequency of occurrence of the two or more names.”

Turnbull does not disclose nor make obvious at least the limitations (ii) and (iii), above. If we assume that Fig. 4 #80 of Turnbull is the second term (i.e., “cooking” in the example provided in Turnbull at paragraph 61) and that the subcategory names “Barbecues,” “Cookware,” “Cutlery” and “Equipment” are the “two or more names” then clearly Turnbull does not show “determining a frequency of occurrence “of these names in documents that also “satisfy the first search term.”

This is because Fig. 4 and paragraphs 60-62 of Turnbull deal with web page browsing and not document searching. Turnbull at paragraph 59. The terms and names in Fig. 4 are categories, not documents or names that must appear in documents, and are part of a “categorical taxonomy”. Turnbull at paragraph 59. Turnbull’s subcategory names subjectively describe the types of content that can be browsed. The content is not organized by occurrence of the names within documents. Rather, Turnbull’s terms and names generally describe the type of content to which content pointers such as #88 refer. This is why these names are called “categories” or “subcategories” and “can be configured to represent a categorical hierarchical structure”. Turnbull at paragraph 62.

Neither Turnbull nor Miller disclose nor make obvious “wherein the presented identified documents are ordered according to the determined frequency of occurrence of the two or more names within the identified documents” as recited in the amended claims. Although the Office Action states that “Turnbull discloses an ordering of names (#82)” (Office Action at page 9) this is not a limitation in the claims. Miller does not disclose any ordering of results much less results of documents that “satisfy a first search term” that are also “ordered according to the determined frequency of occurrence of the two or more names within the identified documents”. Note that Miller’s discussion of word occurrences and ranking such as at Figs. 10A-11B and related text is in relation to forming the thesaurus database and not to presenting results to a user.

Additional dependent claims provide additional limitations not disclosed by nor made obvious in view of the prior art.

Application No. 10/759,784
Trellis Ref.: 010023-001700US
Client Ref.: 2003-540-1

Applicant respectfully submits that the present claims are in condition for allowance and an early Notice of Allowance is earnestly sought. The undersigned may be contacted at the 415-279-5098 at the Examiner's convenience if it would help in the prosecution of this matter.

Respectfully submitted,

TRELLIS INTELLECTUAL PROPERTY
LAW GROUP, PC

By 
Charles J. Kulas
Reg. No. 35,809
Tel.: 415-279-5098